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IN THE

Supreme Court of the United States

No. 865

W. D. HADEN COMPANY,
Petitioner,

vs.

THE MATHIESON ALKALI WORKS, INC.,
Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

RAYMOND F. ADAMS
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January 30, 1942

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Statement of the Case

Respondent has been engaged in the manufacture of alkalies from calcium carbonate and salt at Saltville, Virginia for many years (II. 1189-90, 1364-6). After an investigation begun in the late 1920s, it constructed a plant for conducting these operations at Lake Charles, Louisiana and some time later put the plant in operation (I. 551, II. 1385).

Calcium carbonate, available as limestone at Saltville, was available as dredge-washed oyster shells at Lake Charles. Such dredge-washed oyster shells, dredged and washed with conventional equipment, had been a commodity available in that vicinity prior to petitioner's first

work in making lime from shells (I. 206-9, II. 891, 1104, 1131-2). The use of a rotary kiln for calcining shell as well as limestone was not novel with petitioner (IV. 2433, 2483 bottom left column, 2486 under conclusions).

In respondent's practice at Lake Charles such dredge-washed shells are charged, by the use of conventional handling and conveying equipment, into rotary kilns (IV. 2350-2, II. 1104-1115, 1160, 1175-7, III. 1510, 1836, 1935, IV. 2358, 2377). No crusher of any kind is used. The shell material entering the kiln is not sized but ranges from whole shells to dust (IV. 2631-2, respondent's Exh. 27 reporting petitioner's analysis per II. 868-70, and see II. 879, 1065-7, III. 1521-5). In the kiln the shell material is calcined to produce lime and carbon dioxide both of which are used in respondent's own operations (II. 1364-6). The purity of the lime is substantially lower than that petitioner asserts to be characteristic of its product. (Compare petitioner's Exh. T-12, IV. 2172, corrected per I. 567-70, with petitioner's Exh. T-11, IV. 2177).

During respondent's investigation, respondent was referred to petitioner by an associate to which petitioner was then supplying dredge-washed shell (III. 1803). Petitioner, which had previously published the details of its operations (I. 323-7, II. 895-7, IV. 2103, 2185, 2632-8), tried to get from respondent a contract for its shell requirements and to satisfy respondent that the shells it would supply were suitable for conversion into carbon dioxide and lime (I. 175-6, 326-9). During negotiations petitioner's patent appeared and petitioner advised respondent that petitioner expected the patent to protect the petitioner's shell business and to secure for petitioner a limited monopoly in the unpatented material, dredge-washed shell (IV. 2288-90, petitioner's Exh. X-131).

The patent in suit (III. 2028-32) describes and claims a process characterized as an "exact procedure" comprising crushing, washing and sizing of shell supplied to a rotary kiln. After stating that a majority of the silt and

sand can be removed by using a rotary screen with the mechanical dredging equipment usually employed (page 1, lines 85-99), the patent specification states that nevertheless small deposits of sand and silt remain "included in the shell structure" and then states that, in the process of the patent, this shell material is crushed, to expose dirt trapped within the shell structure for removal by subsequent washing, and to limit the maximum size of the pieces of shell (page 1, line 99-page 2, line 26).

There is no reference in the specification to any crushing in the conventional dredge or dredge screen, or in conventional handling equipment, or to petitioner's term "surface crushing". Distinction between kinds of crushing, one of which cleans without sizing and another which sizes without cleaning, urged by petitioner, is without support in the specification. The only crushing described in the specification is done in a crusher which both liberates dirt included in the shell structure and limits the maximum size of the pieces of shell.

The application for patent, as filed, included other claims broader than those of the patent (IV. 2401, claims originally numbered 1, 2, 3 and 4). These other claims were not limited to a process including the step of crushing or the step of sizing. These other claims were rejected on art and cancelled under rejection in order to secure the patent (IV. 2405, 2415, 2425 and 2426).

Respondent, exercising its right to be free with respect to dredge-washed shell, an unpatented and unpatentable commodity, made arrangements to obtain its shell from others (III. 1795, 1798, IV. 2222-4). This suit was thereupon instituted.

The District Court construed the claims of the patent by reference to other claims rejected and cancelled during prosecution of the application and found the patent so construed to be valid but not infringed (Opinion I. 65-82). The Court of Appeals affirmed the District Court (Opinion IV. 2652-5).

Argument

Petitioner's argument proceeds upon an incorrect representation of the basis on which the courts below determined the scope of the claims of the patent, and particularly claim 2. Petitioner correctly quotes the Court of Appeals as saying that "Claim 2, which includes crushing of oyster shells must be read in connection with the other claims." (Brief p. 16). The Court of Appeals said this after saying that the District Court had held that " 'crushing' as used in claim 2 was qualified by the other claims to mean sizing" (IV. 2654). The "other claims" to which both courts referred were the rejected claims cancelled during prosecution of the application on which the patent issued. The first twelve pages of the District Court's opinion are devoted to an identification of the subject matter of these other claims and an analysis of the effect of their rejection and cancellation upon the scope of the remaining claims under the doctrine of *I. T. S. Rubber Co.* v. *Essex Rubber Co.*, 272 U. S. 429, 443 (I. 65-77). Neither court applied the rule petitioner suggests to have been the basis for the asserted error upon which petitioner relies. Both courts applied a very different rule and a correct rule. The rule applied by both courts was reaffirmed by this Court, after the District Court's opinion and before affirmance by the Court of Appeals in *Schriber-Schroth Co.* v. *Cleveland Trust Co., et al.*, 311 U. S. 211, 220.

Petitioner presents a false issue, apparently seeking to have the real issue of infringement redetermined without reference to those restrictions in scope the Court of Appeals and the District Court found necessary to sustain the validity of the patent.

This is an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement. The usual rules have been applied in the usual way in determining these issues. The determination of the issues

rests on concurrent findings of validity of the patent and non-infringement by respondent by the courts below. There is no conflict of decision and no proper or adequate showing of improbability of conflict (*post* p. 6). The adjudication of validity does not impair petitioner's right to enforce the patent against infringement of the process of the patent.

We therefore submit that the petition should be denied.

RAYMOND F. ADAMS
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